

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of

Confirmation No. **3628**

TELIMAA et al

Atty. Ref.: **2747-4**

Serial No. **10/579,835**

Group: **1797**

Filed: **June 8, 2006**

Examiner: **Gerido**

For: **ELECTRIC PIPETTE**

* * * * *

May 7, 2009

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

APPLICANTS' BRIEF ON APPEAL

Sir:

This Appeal is from the Official Action dated December 19, 2008, finally rejecting claims 1-16 presently pending herein.¹ As will become evident from the following discussion, the Examiner's rejections are in error and, as such, reversal of the same is solicited.

¹ The claims on appeal appear in the Section VIII Claims Appendix accompanying this Brief.

TELIMAA et al
Serial No. 10/579,835
May 7, 2009

I. Real Party In Interest

The real party in interest is the owner of the subject application, namely Thermo Electron Oy.

TELIMAA et al
Serial No. 10/579,835
May 7, 2009

II. Related Appeals and Interferences

No known appeals and/or interferences are pending that are related to the subject application.

III. Status of Claims

- A. The following claims are presently pending in this application: Claims 1-16.
- B. The following claims are the claims on appeal and have been rejected in the Examiner's "final" Official Action of July 22, 2008: Claims 1-16.
- C. The following claims have been cancelled during prosecution to date: None.
- D. The following claim(s) have been allowed: None
- E. The following claims have been withdrawn: None
- F. The following claims have been objected to: None

TELIMAA et al
Serial No. 10/579,835
May 7, 2009

IV. Status of Amendments

No amendments subsequent to the Official Action dated December 19, 2008 have been filed.

V. Summary of Claimed Subject Matter²

The invention as defined by independent claim 1 (the sole independent claim pending herein for consideration) is directed toward an electric pipette (page 1, line 6 and numeral 1 in Figs. 1-5) comprising a body (numeral 2 in Figs 1-2) having a vertical axis (numeral 3 in Figs. 1-2), a tip part (numeral 4 in Figs. 1-2), a hook part (numeral 5 in Figs. 1-5), a push-button part (numeral 6 in Figs. 1-5) and a display part (numeral 7 in Figs. 1-7). The electric pipette includes at least two rotatable parts selected from the group consisting of the hook part, the push-button part and the display part which are rotatable through angles φ_1 , φ_2 and φ_3 , respectively, about the vertical axis of the electric pipette body (page 4, lines 10-19 and Fig. 4).

² The numbers in parenthesis refer to the reference page and line numbers of the originally filed specification and/or the reference numeral and drawing figure as originally filed.

VI. Grounds of Rejection to be Reviewed on Appeal

The following rejection was advanced in the final Official Action dated December 19, 2008:

1. Claim 1 has been rejection under 35 USC §112, second paragraph as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
2. Claims 1-5 and 9-13 have been rejected under 35 USC §103(a) as allegedly being unpatentable over Scordato et al (US 2002/0012613) in view of Oshikubo (USP 4,909,991).
3. Claims 6-8 and 14-16 have been rejected under 35 USC §103(a) as allegedly being unpatentable over Scordato et al in view of Oshikubo as applied to claim 10, and further in view of Jarvimaki et al (USP 4,988,481).

VII. Arguments

1. Claim 1 is statutorily definite.

The Examiner asserts that:

“[A]pplicant recites angles φ_{1-3} without stating parameters for the claimed angles. For the purposes of examination, angles φ_{1-3} will be regarded as any angles between 0-360⁰.”
(Office Action of December 19, 2008 at page 2, paragraph 2, lines 3-5.)

Applicants suggest that the issue here is one of scope of protection to be afforded to the presently claimed invention – not one of indefiniteness. Thus, the fact that angles φ_{1-3} may be interpreted in the manner noted by the Examiner does not per se render claim 1 statutorily indefinite. Thus, as presented, the recitations of the angles φ_{1-3} are in fact statutorily definite.

The Examiner further asserts that:

“[I]t is unclear as to what applicant regards as the display part as applicant does not specify any structure to differentiate the display part from other components of the claimed pipette.”

With all due respect, the “display part” is precisely what it purports to be – namely a part with a display. Such a part is unmistakably differentiated from the “tip part” (i.e., a part with a tip), the “hook part” (i.e., a part with a hook) and a push-button part (i.e., a part with a push-button). Thus, contrary to the Examiner’s assertions, the “display part” most certainly is differentiated from the other claimed parts.

Reversal of the Examiner's rejection advanced against claim 1 under 35 USC §112, second paragraph is therefore in order.

2. Claims 1-5 and 9-13 are patentably unobvious over Scordato et al in view of Oshikubo.

Applicants note that, while the pipette of Scordato et al is somewhat similar to the pipette of the present invention, the former has only a single component part that is rotatable relative to the pipette body's vertical axis, namely the hook part 16 which may be rotatably varied relative to the nozzle portion 14 between 150° to 210° (paragraph [0028]). In contrast, according to the present invention, an electric pipette is provided which includes at least two rotatable parts selected from the hook part, the push-button part and the display part which are rotatable about the vertical axis of the electric pipette body.

Moreover, Scordato et al does not propose a display part. And the push-button part (i.e., the plunger 18) of Scordato et al operates coaxially with the vertical axis of the pipette body. As such, an ordinarily skilled person would not have considered to have provided either or both such parts as rotatable structures relative to the vertical axis of the pipette body.

The applied Oshikubo reference fails to cure the deficiencies of Scordato et al noted above. While it is true that Oshikubo reference discloses some sort of "display mechanism", it is equally true that the display mechanism of Oshikubo cannot be rotatably *inclined* relative to the vertical axis of the pipette body. Instead the viewing angle of the "display mechanism" relative to a user according to Oshikubo remains fixed. Therefore, even if an ordinarily skilled person were to combine Scordato et al with Oshikubo, the invention defined by claims 1-5 and 9-13 would not result.

Reversal of the Examiner's rejection of claims 1-5 and 9-13 under 35 USC §103(a) based on Scordato et al and Oshikubo is therefore in order.

3. Claims 6-8 and 14-16 are patentably unobvious over Scordato et al in view of Oshikubo and Jarvinaki et al.

The discussion above in Section 3 is equally germane to the unobviousness of claims 6-8 and 14-16 based on Scordato et al in view of Oshikubo and Jarvinaki et al.

Applicants further note that Jarvinaki et al merely makes reference at column 2, lines 64-68 to some sort of liquid crystal display that may be connected operatively to receive a signal from the electronics card 32. However, the location of the display on either the handle member 1 or the body member 2 is not disclosed in Jarvinaki et al. WO 87/00085 referenced at column 1, lines 12-14 of Jarvinaki et al in fact shows a display 33 associated with a fixed-position handle/body member. Thus, at best Jarvinaki et al would lead an ordinarily skilled person to a system wherein the display is fixed on the body member and **not** adjustable about a horizontal axis **and** a vertical axis of such body member.

Accordingly, even if an ordinarily skilled person were to combine Jarvinaki et al with Scordato et al and Oshikubo, the presently claimed invention defined by claims 6-8 and 14-16 would not be the result.

Withdrawal of the rejection advanced against claims 6-8 and 14-16 under 35 USC §103(a) based on Scordato et al in view of Oshikubo and Jarvinaki et al is therefore in order.

TELIMAA et al
Serial No. 10/579,835
May 7, 2009

4. Conclusion.

For the reasons advanced, the Examiner's rejections of the pending claims herein are in error and must be reversed. Such favorable action is solicited.

Respectfully submitted,

NIXON & VANDERHYE P.C.

By: /Bryan H. Davidson/
Bryan H. Davidson
Reg. No. 30,251

BHD:dlb
1100 North Glebe Road, 8th Floor
Arlington, VA 22201-4714
Telephone: (703) 816-4000
Facsimile: (703) 816-4100

VIII. CLAIMS APPENDIX

1. (previously presented) An electric pipette comprising a body having a vertical axis, a tip part, a hook part, a push-button part and a display part, wherein the electric pipette includes at least two rotatable parts selected from the group consisting of the hook part, the push-button part and the display part which are rotatable through angles φ_1 , φ_2 and φ_3 , respectively, about the vertical axis of the electric pipette body.
2. (previously presented) An electric pipette according to claim 1, wherein the at least two rotatable parts are rotatable 0-360° about the vertical axis of the electric pipette body.
3. (previously presented) An electric pipette according to claim 1, wherein at least one of the angles φ_1 , φ_2 or φ_3 is in the range $-90 - 90^\circ$.
4. (previously presented) An electric pipette according to claim 1, wherein at least one of the angles φ_1 , φ_2 or φ_3 is in the range $-70 - 70^\circ$.
5. (previously presented) An electric pipette according to claim 1, wherein at least one of the angles φ_1 , φ_2 or φ_3 is in the range $-50 - 50^\circ$.
6. (previously presented) An electric pipette according to claim 2, wherein the display part is rotatable about a horizontal axis of the pipette body so as to permit inclination thereof at an angle α in the range 0-60° relative to the vertical axis of the electric pipette body.
7. (previously presented) An electric pipette according to claim 2, wherein the display part is rotatable about a horizontal axis of the pipette body so as to permit inclination thereof at an angle α in the range 0-50° relative to the vertical axis of the electric pipette body.

8. (previously presented) An electric pipette according to claim 2, wherein the display part display part is rotatable about a horizontal axis of the pipette body so as to permit inclination thereof at an angle α in the range 0-40° relative to the vertical axis of the electric pipette body.
9. (previously presented) An electric pipette according to claim 1, wherein each of the hook part, the push-button part and the display part is rotatable through angles φ_1 , φ_2 and φ_3 , respectively, about the vertical axis of the electric pipette body.
10. (previously presented) An electric pipette according to claim 1, wherein each of the hook part, the push-button part and the display part is rotatable 0-360° about the vertical axis of the electric pipette body.
11. (previously presented) An electric pipette according to claim 9, wherein at least one of the angles φ_1 , φ_2 or φ_3 is in the range -90 – 90 °.
12. (previously presented) An electric pipette according to claim 9, wherein at least one of the angles φ_1 , φ_2 or φ_3 is in the range -70 – 70 °.
13. (previously presented) An electric pipette according to claim 9, wherein at least one of the angles φ_1 , φ_2 or φ_3 is in the range -50 – 50 °.
14. (previously presented) An electric pipette according to claim 10, wherein the display part is rotatable about a horizontal axis of the pipette body so as to permit inclination thereof at an angle α in the range 0-60° relative to the vertical axis of the electric pipette body.
15. (previously presented) An electric pipette according to claim 10, wherein the display part is rotatable about a horizontal axis of the pipette body so as to permit

inclination thereof at an angle α in the range 0-50° relative to the vertical axis of the electric pipette body.

16. (previously presented) An electric pipette according to claim 10, wherein the display part is rotatable about a horizontal axis of the pipette body so as to permit inclination thereof at an angle α in the range 0-40° relative to the vertical axis of the electric pipette body.

TELIMAA et al
Serial No. 10/579,835
May 7, 2009

IX. EVIDENCE APPENDIX

[NONE]

TELIMAA et al
Serial No. 10/579,835
May 7, 2009

X. RELATED PROCEEDINGS APPENDIX

[NONE]

TELIMAA et al
Serial No. 10/579,835
May 7, 2009

XI. CERTIFICATE OF SERVICE

[NOT APPLICABLE]